



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,268	03/23/2004	Atsushi Tanno	OGW-0313	1911

23353 7590 03/10/2006

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

JOHNSTONE, ADRIENNE C

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,268

Applicant(s)

TANNO, ATSUSHI

Examiner

Adrienne C. Johnstone

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-6 in the reply filed on January 20, 2006 is acknowledged. The traversal is on the ground(s) that 1) all of the subcombination resonance suppression device limitations are recited in the combination tire claims and therefore the combination as claimed must require the particulars of the subcombination as claimed for patentability, therefore the restriction requirement does not show that the subcombination as claimed is patentably distinct from the combination as claimed, and 2) serious burden was not shown in the restriction requirement. This is not found persuasive because 1) applicant has not admitted on the record that the subcombination as claimed is not patentably distinct from the combination as claimed (in which case one would necessarily be obvious in view of the other by applicant's admission), and it was shown in paragraph 2 of the restriction requirement that the particulars of the subcombination as claimed are not required *for patentability* of the combination as claimed because the combination as claimed also requires a) pneumatic tire structure and b) attachment of the device to the tread inner surface rather than to another location on the tire inner surface or to a location on the rim, either or both of which could be the basis for patentability of the combination: these characteristics particular to the combination tire claims provide a reasonable basis for showing that the particular characteristics of the subcombination resonance suppression device claims do not constitute the sole basis for patentability of the combination and therefore the particulars of the subcombination as claimed are not required *for patentability* of the combination (to show novelty and unobviousness, MPEP 806.05(c)); and 2) it was shown in paragraphs 1 and 3 of the restriction requirement that the inventions have acquired a separate status in the art as shown by their different classification, and this constitutes a *prima facie* showing of serious burden which has

not yet been rebutted by applicant submitting the appropriate showings or evidence (MPEP 803 (II)).

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 7-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on January 20, 2006.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Japanese Patent Application 2000-62408 A (translation attached).

5. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Published PCT Application WO 02/085648 A1 or, alternatively, Nishikawa (6,343,843 B1).

See WO '648 embodiments of Figures 1-3, paragraphs 05-038: flexible sound-absorbing ring 40, 41 formed from rubber or plastic strip 42, 43 is fixed to the tread inner surface and includes ridges 42, 45 and gaps 46, 47 on circumferential base 48, and the strip can be made of a tape or ribbon circumferential base (variable-circumference ring-shaped jig made of an elastic body) having blocks bonded thereto.

Alternatively, see Nishikawa embodiment of Figure 1, col. 2 line 3 - col. 3 line 7: noise damper 5 includes continuous circumferential base strip 5a made of a sheet of elastomeric material

Art Unit: 1733

(variable-circumference ring-shaped jig made of an elastic body) and noise damping material made of yarn tufts 5b.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Published PCT Application WO 02/085648 A1 in view of European Patent Application 1 092 567 A2 and US Patent Application Publication 2001/0007268 A1 or, alternatively, Nishikawa (6,343,843 B1) in view of European Patent Application 1 092 567 A2 and US Patent Application Publication 2001/0007268 A1.

See paragraph 5 above: it is well known to provide a circumferential change in cross-sectional area in the tire cavity of such tires having a value within applicant's broad range of 0.25% to 40% in order to minimize noise, as evidenced by EP '567 (paragraphs 0012 and 0036, at least 2.5%) and US '268 (paragraph 0064, at least 5%) for example; it would therefore have been obvious to one of ordinary skill in the art to provide such well known circumferential change in cross-sectional area in the tire cavity of the above tire in order to minimize noise.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japanese Patent Applications 6-106903 A and 9-86113 A disclose examples of the prior

Art Unit: 1733

art tire similar to the claimed tire but wherein the jig is attached to the rim instead of the tread inner surface.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adrienne C. Johnstone whose telephone number is (571) 272-1218. The examiner can normally be reached on Monday-Friday, 10:30AM-7:00PM.

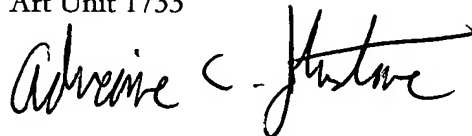
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Adrienne Johnstone

March 6, 2005

Adrienne C. Johnstone
Primary Examiner
Art Unit 1733

A handwritten signature in black ink, appearing to read "Adrienne C. Johnstone", written in a cursive style.